



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

) Examiner: B. Edelman

RECEIVED

James Prescott Curry

) Art Unit: 2153

JUN 09 2004

)

Technology Center 2100

Serial No.: 09/449,237

) Atty. Docket No. 44884.12.1

)

Filed: 24 Nov. 1999

)

)

For: METHOD AND SYSTEM FOR)

PROVIDING ON-LINE WELLNESS)

AND RETAIL ACCESS THROUGH)

A DISTRIBUTED NETWORK)

SENT VIA U.S. MAIL

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Commissioner for Patents

P.O. Box 1450

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*Appellant's Reply Brief
Serial No.: 09/449,237
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REPLY BRIEF (37 C.F.R. § 1.193(b)(1))

This is a Reply Brief to the Examiner's Answer mailed on April 2, 2004.

CONCLUSION

Applicant has carefully reviewed the Examiner's Answer. Applicant stands by all statements made in the Appeal Brief.

In the Examiner's Answer, an argument previously made was repeated, with respect to claims 81, 93, and 85. The Examiner's Answer argued again that the contents of the database, the location of the kiosks for entering data into the database, and the sponsorship of the kiosks were merely descriptive, and not functionally involved in the recited steps. The Examiner repeated this argument in another form in the Examiner's Answer, arguing that the type of information and the location of the kiosk is a non-functional field of use.

Applicant respectfully responds that the wellness related database, the location of the kiosk in a fitness center, and the sponsorship of the kiosk by the fitness center, are all limitations that are functionally related to each other. In the real, physical world, these limitations are functionally related to each other and to the recited steps. Additionally, acts not including these limitations would not literally infringe the claims. Therefore, the limitations are limiting. Applicant agrees that a non-novel database package, a non-novel computer, a non-novel kiosk, and non-novel networking software could be used to implement some

embodiments of the invention recited in claims 81, 93, and 85. Applicant submits that the Examiner has added a "technical effect" requirement to U.S. patent law to read out limitations that are limiting, but are not technical in nature.

The Examiner has cited *In re Lowry* for the proposition that "descriptive" material will not distinguish a claimed invention from the prior art in terms of patentability. The *Lowry* court stated that "the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent" (emphasis added). Applicant submits that, given the functional relationships described between the claim limitations above, the Examiner has not established a prima facie case of unpatentability.

Applicant appreciates the difficulty in prior art searching in inventive areas such as this. However, a proper rejection under 35 U.S.C. 103(a) should be based on a reference or set of references that teach or suggest the claimed invention. The rejection should not be based on dismissing the limitations of major portions of the claimed invention, then citing references that do not teach the claimed invention. In the present appeal, the rejection should not be based on deleting the non-computer hardware-software limitations, even though functionally inter-related, and then rejecting what remains of the claims over references that do not teach the originally claimed invention.

The present invention, filed four years ago, provided methods for entering fitness data at a fitness center and viewing them at home. The invention also provided fitness centers financial

reasons synergistically related to the content, location, use and properties of the kiosks to provide kiosks for their members. The prior art provided by the Examiner did not provide this. This has further resulted in a curtailment of patent rights to the Applicant and is an improper application of the law. Rather a failure to identify and apply specific prior art should lead to allowance rather than Final Rejections of these claims.

Reversal of the rejection of claims 81-93 and 95-97 is believed warranted and is solicited.

Respectfully submitted,

Dated: June 2, 2004



Craig F. Taylor
Reg. No. 40,199
FREDRIKSON & BYRON, P.A.
022859
Cust. No. 022859
4000 Pillsbury Center
200 South Sixth Street
Minneapolis MN 55402-1425
(612) 492-7000

#2975227\1